RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP NO. 1642

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Adair et al.	**Confirmation No. 9631**
Serial No.: 08/846,658	**Group Art Unit: 1642**
Filing Date: May 1, 1997	**Examiner: Davis, Minh Tam B.**
For: HUMANISED ANTIBODIES	

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BOX RCE
Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

REQUEST FOR RECONSIDERATION

This paper is being filed in conjunction with a Request for Continued Examination in response to the Final Rejection dated December 18, 2001, following a Notice of Appeal filed June 18, 2002, received by the Patent Office June 24, 2002. A petition for a four-month extension of time, and the appropriate fee, accompany this response.

REMARKS

Claims 24-31 were pending. All pending claims were rejected in the Final Rejection. A Request for Reconsideration was submitted May 20, 2002. An Advisory Action was mailed August 28, 2002. In the Advisory Action, the Examiner indicated that the amendment (presumably the Request) would be entered upon appeal. Applicants are not resubmitting the May 20, 2002 Request for Reconsideration and accompanying papers on the assumption that it will be entered in the record. If Applicants' assumption is incorrect, they ask that the Examiner so advise and they will resubmit the papers filed May 20, 2002.

The Advisory Action indicated that the rejection of the claims under 35 U.S.C. § 102(e) over U.S. Patent No. 5,585,089 ("the Queen patent") was maintained. Applicants

respectfully request withdrawal of this rejection in view of the documents submitted May 20, 2002 and the following arguments.

In the Request filed May 20, 2002, Applicants submitted numerous documents to support their argument that the Queen patent cannot be used as a reference under 35 U.S.C. § 102(e). Specifically, Applicants argued that the Queen patent was not entitled to the dates of its two earliest priority applications. Such arguments referred to the filing by Queen of several continuation-in-part applications (the second and third applications in the series) and MPEP 2136.03. MPEP 2136.03 cites *In re Wertheim*, 209 USPQ 554 (CCPA 1981) for the principle that the claims as allowed must be supported in any earlier filed applications for the patent to be effective as a reference as of the filing date of any such earlier application.

The documents submitted May 20, 2002 included statements made by the Patentee (Queen) during the prosecution of *inter partes* oppositions against the grant of European counterparts to the Queen patent.

In the Advisory Action, the Examiner stated the following:

> Pages 6-7 of Exhibit 6 concern how one would interpret claim 1 in a divisional of Queen's European patent 0 451 216 B1, which is not relevant to the issue of whether there is support for CDRs as defined by Chothia et al in Queen '975. Further, the paragraph "nowhere does the contest Patent state that the Chothia definition is to be used in carrying out the invention or in understanding the claims" does not support the implication that Queen et al state that the specification of Queen '975 does not have support for the Chothia definition, since said paragraph clearly seems to be referred to the content of the added passage to Queen's European patent 0 451 216 B1, which has been alleged by some the Opponents as altering and adds to the meaning of claim 1 (see page 5 of Exhibit 6).

It appears, from this passage, that the Examiner feels that what was argued by the Patentees and found to be unsupported in the European counterparts is not relevant to the U.S. prosecution. Applicants respectfully disagree.

Quite the contrary, both are highly relevant - Queen's European counterparts claim priority to the **very same** two earlier priority applications referred to above. Applicants are arguing that these two applications do not support the claims of the issued Queen patent. Applicants stated this on page 3 of their May 20, 2002 Request. The Examiner is also directed to Exhibit 1 attached to the May 20, 2002 Request, which is a copy of European Patent 0 451 216 B1. It is thereon indicated that the European patent claims priority to US 290975, filed December 28, 1988 (i.e., Queen '975) and US 310252, filed February 13, 1989 (i.e., Queen '252). Further, on page 7 of Exhibit 6, the Patentees (Queen) argued that

> . . . the Patent unequivocably [sic] uses the *Kabat* definition for the framework region, i.e. the part of the variable region other than the Kabat CDRs. **This same definition was given in the priority documents and the application as filed.**

It is difficult to conceive of how the same priority documents fail to support a particular definition in Europe, but support the **very same** definition in the U.S.

Applicant's position is that Queen has acknowledged that his earlier two applications do not support the "Kabat plus Chothia" definition of the CDRs as used in Queen's issued claims. Thus, the Queen patent is not entitled to the dates of those earliest two applications. Therefore, the Queen patent is not a reference under 35 U.S.C. § 102(e) and all the claims are allowable.

Applicants respectfully submit that the application is in condition for allowance and request early notification of the same. If the Examiner disagrees, or feels a telephonic interview would be helpful, she is asked to contact the undersigned at 215-665-5593 to discuss.

Respectfully submitted,

Date: December 23, 2002

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